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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,451	12/31/2003	Ross Koningstein	Google-41 (GP-099-00-US)	4989
26479	7590	02/21/2006	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			BEKERMANN, MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/750,451		KONINGSTEIN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Michael Bekerman		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

This action is responsive to papers filed on 12/16/2005

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements.** See MPEP § 2172.01. The omitted elements relate to the following: It is unclear as to how unused inventory and unused ad spots are determined. Examiner recommends the defining a webpage with a finite number of ad spots, the showing of advertisements on the webpage, and the determining that not all ad spots are filled to define unused inventory.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. **Claims 1, 3-10, 14, 16-23, 27, 29-36, 40-42, 44-51, 55, 57-64, 68, 70-77, and 81-85 are rejected under 35 U.S.C. 102(e) as being anticipated by Paine (U.S. Pub. No. 2003/0055816).** Paine shows a method and apparatus for recommending search terms to an advertiser that includes all of the limitations recited in the above claims.

**Referring to claims 1, 14, 42, and 55,** Paine teaches a method and apparatus for determining one or more ad targeting keywords comprising accepting at least one category (search terms in the initial list are considered to be categories), determining one or more keywords using the accepted at least one category, providing the determined one or more keywords as suggested targeting keywords to an advertiser, accepting advertiser input in response to the suggested targeting keywords, and determining whether or not to provide at least some of the determined one or more keywords as targeting keywords for an ad using the accepted advertiser input (Paragraph 0107, Sentence 1).

**Referring to claims 27, 40, 41, 68, and 81-85,** Paine teaches a method and apparatus for generating one or more keywords as candidates for use as ad targeting keywords, comprising the accepting of ad information, the determining of one or more categories using the accepted ad information (Abstract, Sentences 1-3), the recommending of at least one of the one or more of the categories to an advertiser, and the accepting of feedback with respect to the recommended one or more categories (Paragraph 0107, Sentence 1). The search terms referred to by Paine are viewed as serving constraints for the advertisements. By comparing an advertiser to other similar

advertisers (Abstract, Sentence 3), the system would have to determine the initial advertiser's product category.

**Referring to claims 3, 4, 16, 17, 29, 30, 44, 45, 57, 58, 70, and 71,** Paine teaches the determining of at least one category using ad creative information and information from a landing webpage of the advertiser (Abstract, Sentence 2). Examiner considers an advertiser website to contain ad creative information.

**Referring to claims 5, 18, 31, 46, 59, and 72,** Paine teaches inverted an keyword index in which categories are provided as lookup keys to keywords (Paragraph 0080, Sentences 1-4). Examiner considers each of Paine's subaccounts to be a different category.

**Referring to claims 6, 19, 32, 47, 60, and 73,** Paine teaches the performing of qualification testing of the determined one or more keywords to determine if a keyword is qualified or unqualified for use as an ad targeting keyword and the providing of those qualified keywords as ad targeting keyword (Abstract, Sentence 3).

**Referring to claims 7-10, 20-23, 33-36, 48-51, 61-64, and 74-77,** Paine teaches the tracking of the performance of the ads served using an ad targeting keyword. Paine's tracking is performed in general as well as across specific categories, including the accepted category (Paragraph 0087, Sentences 5-7).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 2, 11-13, 15, 24-26, 28, 37-39, 43, 52-54, 56, 65-67, 69, and 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816).**

**Referring to claims 11, 24, 37, 52, 65, and 78,** Paine teaches a system for recommending ad targeting keywords for ads displayed on a search site. Paine doesn't go into detail about the type of space that will be used for the ad on the search site. Official notice is taken that it is well known when a new advertisement is added to a search page, it will be added to an ad spot that would otherwise be unused. It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify an advertisement as being served on a portion of the webpage that would otherwise be unused. This would keep the operator of the search site from overlapping other information with an advertisement.

**Referring to claims 2, 15, 28, 43, 56, and 69,** Paine's invention doesn't teach a tool that keeps track of negative ad targeting keywords. Paine does teach that it is well known to have a tool to keep track of two lists, a list of good words for an advertiser's site and a list of negative keywords having no relation to the advertisers site or content (Paragraph 0008, Sentence 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include negative keywords into the system of Paine. This would allow more accuracy in relation to relevant keywords.

**Referring to claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80,** Paine teaches filling unused inventory ad spots with unpaid listings generated by a search engine (Paragraph 0075, Sentences 10-11). Paine does not teach any attempt to fill those unused spots with other paying advertisements. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the webpage owner would want to recommend keywords to a paying advertiser for which there were more spots available. This will ensure that less ad spots will be unpaid-for.

### ***Response to Arguments***

In response to the 102(e) rejection of claims 1, 3-10, 14, 16-23, 27, 29-36, 40-42, 44-51, 55, 57-64, 68, 70-77, and 81-85, applicant argues that neither spidering, nor collaborative filtering, nor their combination, teach an act of or means for determining one or more keywords using at least one category. Applicant state's on page 27 of the amendment that "spidering may provide recommended search terms which a new advertiser may accept or reject" and "collaborative filtering may be used to provide an updated list of search terms which may be accepted or rejected" (both of these concepts are taught by Paine). Examiner considers a search term to be a category. In figure 9, Paine uses "automobile" as an example of a search term. On page 32 of the amendment, applicant refers to "automobile" as an example of a category. Based on this information, Paine reads on the above claims and the rejection still stands.

In response to the 103(a) rejection of claims 2, 15, 28, 43, 56, and 69, applicant argues that Paine teaches "positive and negative scores assigned to keywords for

determining whether a new advertiser is similar to an existing advertiser.” Paragraph 0008 of Paine recites: “This tool keeps track of two lists; an accept list of good words for an advertiser’s site, and a reject list of bad words or words that have no relation to the advertiser’s site or it’s content”. Examiner feels that this is sufficient material to read over the above claims and the rejection still stands.

In response to the 103(a) rejection of claims 11, 24, 37, 52, 65, and 78, applicant amended claims to read “available ad spots that otherwise would be unused by any ads”. This amendment does not distinguish over Paine, and it would be still be obvious to not place an advertisement over any other information (or advertisement) on the webpage. Based on this information, the rejection still stands.

In response to the 103(a) rejection of claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80, applicant argues that previous prior art reference Kurtzman does not teach the displaying of advertisements based on unused inventory. Examiner accepts applicant’s argument and Kurtzman has been dropped from the rejection. Examiner sets forth a new 103(a) rejection for the above claims that uses Paine alone.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone

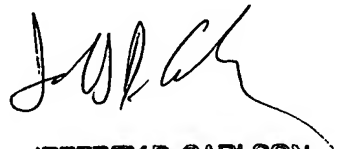


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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**